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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,787	03/01/2000	Steven M.H. Wallman	10392/46801	3234

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EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/516,787

Applicant(s)

WALLMAN, STEVEN M.H.

Examiner

Stefano Karmis

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klw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to Applicant's amendment filed 18 August 2004.

#### ***Status of Claims***

2. Claims 1-76 are left as originally filed. Therefore claims 1-76 are under prosecution in this application.

#### ***Response to Amendment***

3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

#### ***Response to Arguments***

4. Applicant's arguments, filed 18 August 2004, with respect to the rejection(s) of claim(s) 1-87 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. Therefore claims 1-76 are rejected and Applicants request for allowance is respectfully denied.

5. Applicant's arguments with respect to claim 1-87 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 2 of Application No. 09/516,792. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 76 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 76, the term "beta" lacks an antecedent basis. There is no mention in the claims to allow one of ordinary skill in the art to decipher the meaning of this term.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-63, 65-67 and 74-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Breen et al. (hereinafter Breen) U.S. Patent 6,615,188.

Regarding independent claim 1, Breen discloses a method for processing a plurality of trading orders for at least one instrument comprising: combining a value-based order for the at least one instrument and a share-based order for the at least one instrument to create a final trading order for the at least one instrument (column 9, lines 18-32 and column 10, lines 1-24).

Claims 2, 13, 23, 34 and 49, converting the value-based order into a converted share-based order using a predetermined price per share (column 8, lines 18-62 and column 12, lines 1-47).

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Claims 3 and 24, netting any buy orders in a plurality of share based orders against any sell orders in a plurality of share-based orders to form a net share-based order (column 12, lines 1-27).

Claims 4 and 25, netting any buy orders in a plurality of value-based orders against any sell orders in a plurality of value-based orders to form a net share-based order (column 12, lines 1-27).

Claims 5-10, 26-31, and 44-45, aggregating a plurality of orders for at least one instrument into an aggregate based buy or sell order (column 10, lines 1-25).

Claims 11, 12, 32, 33, 46 and 47, netting an aggregate buy order for the at least one instrument against an aggregate sell order for at least one instrument to form a net order to the at least one instrument (column 8, lines 18-48 and column 12, lines 1-27).

Claims 14, 15, 35, and 36, receiving a plurality of value and share based orders for at least one instrument (column 9, lines 18-47).

Claims 16-21, 37-42 and 51-56, the predetermined price includes a midpoint between a bid price and an ask price, and a weighted average for both buy and sell orders (column 8, lines 18-62 and column 12, lines 52-68 and Figures 2-3).

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Claim 22, combining a value-based order for the at least one instrument and a share based order for at least one instrument to form a final order for the at least one instrument (column 9, lines 18-32 and column 10, lines 1-24).

Regarding independent claim 43, receiving a plurality of value-based orders for the at least one instrument from a first plurality of investors; and receiving a plurality of share-based orders for the at least one instrument from a second plurality of investors (column 9, lines 18-32 and column 10, lines 1-24).

Claim 48, aggregating all value-based buy orders for the at least one instrument into a single value-based buy order for the at least one instrument; and aggregating all value-based sell orders for the at least one instrument into a single value-based sell order for the at least one instrument (column 10, lines 1-25); netting the single dollar-based buy order for the at least one instrument against the single value-based sell order for at least one instrument to form a single value-based trading order for the at least one instrument (column 12, lines 1-27).

Claim 50, netting the converted share-based trading order for the at least one instrument against the net share-based trading order for the at least one instrument to form a final trading order for the at least one instrument (column 8, lines 49-62 and column 9, lines 18-32).

Regarding independent claim 57, Breen discloses receiving a plurality of trading orders from the plurality of investors, some of which plurality of trading orders are expressed as value-

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based orders and some of which plurality of trading orders are expressed as share-based orders; and assigning a midpoint price between an ask price and a bid price to each trading floor (column 8, lines 18-62, column 9, lines 18-47 and column 12, lines 52-68 and Figures 2-3).

Claims 58 and 59, wherein buy orders exceed sell orders and orders are assigned a weighted average of the ask price and the midpoint price, and both share and value orders are assigned midpoint prices (column 8, lines 18-62, column 9, lines 18-47 and column 12, lines 52-68 and Figures 2-3).

Regarding independent claims 60 and 61, Breen discloses a method for processing a plurality of trading orders for an instrument comprising: a processor coupled to a memory containing instruction that when executed by the processor cause the processor to: receive a plurality of value-based trading orders, each specified in a particular value basis, receive a plurality of share-based trading orders (column 9, lines 18-32); net all value based trading orders in a similar value basis to create a plurality of net similar-value-basis-value-based trading orders, convert the plurality of net similar-value-basis-value-based trading orders into a plurality of standard-currency based trading orders using a predetermined exchange rate with regard to value basis in the standard currency (column 12, lines 1-27); net the plurality of standard-currency based trading orders to create a net standard-currency-based trading order, convert the net standard -currency based trading order to a converted share-based trading order using a predetermined price for the instrument in the standard currency, and net the converted standard

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currency based trading order and the plurality of share based trading orders to form a plurality of contingent orders (column 12, lines 1-27 and Figure 2 and Figure 3).

Claim 62, 63 and 65-67, Breen discloses receiving a plurality of value-based orders for the at least one instrument, wherein the plurality of value-based orders are specified in a value basis different from that in which the instrument is otherwise priced; receiving a plurality of share-based orders for the at least one instrument from a second plurality of investors; and executing at least one trade in the at least one instrument (column 8, lines 18-62, column 9, lines 18-47 and column 12, lines 1-27 and Figures 2-3).

Claims 74-76, Breen discloses expressing an order for the instrument based on a cumulative effect execution of the order will have on an existing portfolio of investments; and transmitting the order to a third party execution (column 8, lines 18-62, column 9, lines 18-47 and column 12, lines 1-27 and Figures 2-3).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 64 and 68-73 rejected under 35 U.S.C. 103(a) as being unpatentable over Breen et al. (hereinafter Breen) U.S. Patent 6,615,188.

Regarding claims 64 and 68-73, Breen teaches specifying the number of shares to be bought and sold for an instrument in a standard currency (column 9, lines 18-48, column 12, lines 1-27 and column 12, lines 53-67). Breen fails to disclose exchanging the shares into a different currency. Official Notice is taken that currency exchange is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Breen to allow for currency exchange because it provides an efficient manner to globalize the system to consumers trading in overseas markets or located overseas.

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***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted  
Stefano Karmis  
12 October 2004



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